

**Remarks**

This Application has been carefully reviewed in light of the Office Action mailed October 5, 2004. Applicants appreciate the Examiner's consideration of the Application. Applicants have made clarifying amendments to Claim 1. These amendments are not narrowing or necessary for patentability. Applicants respectfully request reconsideration and allowance of all pending claims.

**I. The Claims are Definite under 35 U.S.C. § 112, Second Paragraph**

The Examiner rejects Claims 1-11 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner states that the limitation "the rules comprising one or more generic rules" in Claim 1 "is not clear in juxtaposition to each rule and the specification." (Office Action, Page 2) The Examiner also states that the limitations "the product identifiers" and "non-numerical format" in Claim 1 "are not clear in juxtaposition [to] the specification." (Office Action, Page 2) Applicants respectfully disagree.

Applicants note that the essential inquiry pertaining to the definiteness requirement is whether the claims set out and circumscribe subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (a) the content of the particular application disclosure; (b) the teachings of the prior art; and (c) the claim interpretation that would be given by one possessing ordinary skill in the art at the time the invention was made. M.P.E.P. § 2173.02. Furthermore, the test for indefiniteness under Section 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." M.P.E.P. §2173.02 (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)). Applicants respectfully submit that the meaning of Claims 1-11 would be clear to one of ordinary skill in the art at the time of invention such that these claims comply with 35 U.S.C. § 112, second paragraph.

Prior to the amendments presented in the current Response, the relevant portion of Claim 1 recited, in part:

a content enhancement module operable to:

analyze product data stored in a seller database *using one or more rules, the rules comprising one or more generic rules* applying to substantially all seller databases including product data, the generic rules comprising one or more rules from the group consisting of:

a rule indicating that a potential error exists if two products in the seller database have identical *product identifiers* but have otherwise different product data;

a rule indicating that a potential error exists if two products in the seller database have different *product identifiers* but have otherwise identical product data; and

one or more rules indicating that a potential error exists if the values associated with particular generic product attributes have *a non-numerical format*.

Applicants respectfully submit that the meaning and scope of Claim 1 would be clear to one of ordinary skill in the art, whether the claim is read alone or in combination with the Specification. First, with respect to Claim 1 generally, Applicants respectfully direct the Examiner's attention to at least Page 20, Line 16 through Page 26, Line 13 of the Specification. Second, with respect to the limitation "the rules comprising one or more generic rules," although Applicants believe that the meaning and scope of independent Claim 1 would have been clear to one of ordinary skill in the art without amendment, Applicants have made clarifying amendments to Claim 1. Moreover, Applicants respectfully direct the Examiner's attention to at least Page 21, Lines 3-21 and Page 22, Line 3 through Page 23, Line 15, which provide example descriptions corresponding to the rules comprising one or more generic rules. Third, with respect to "the product identifiers" and "non-numerical format," Applicants respectfully direct the Examiner's attention to at least Page 22, Line 3 through Page 23, Line 15, which provide example descriptions corresponding to "the product identifiers" and "non-numerical format."

The scope of Claims 1-11 is reasonably ascertainable by those skilled in the art and thus the claims are definite. *See* M.P.E.P. § 2173.05(e) (citing *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992)). Applicants respectfully request the Examiner to withdraw the rejections of Claims 1-11 under 35 U.S.C. § 112, second paragraph.

**II. The Claims are Allowable over *Fassett* under 35 U.S.C. § 103(a)**

The Examiner rejects Claims 1-11 and 34-35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,532,481 to Fassett Jr. ("*Fassett*").<sup>1</sup> Applicants respectfully disagree.

*Fassett* merely discloses a computerized product indexing system. (Column 1, Lines 8-10) In particular, *Fassett* discloses a database controller that catalogs a file or product's existence, version, and location using a unique key code, generated automatically, and provides a means for searching for the product by the key code, boolean keyword strings, or catalog topics. (Column 1, Lines 10-15) Suppliers register products with the controller 200 using a registration procedure 160. (Column 3, Lines 7-10)

**A. Independent Claim 1 is Allowable over *Fassett***

Independent Claim 1, as amended, recites:

An electronic commerce system, comprising a content enhancement module operable to:

analyze product data stored in a seller database using one or more rules, the seller database being one of a plurality of seller databases, the rules comprising one or more generic rules applying to substantially all seller databases in the plurality of seller databases that include product data, the generic rules comprising one or more rules from the group consisting of:

a rule indicating that a potential error exists if two products in the seller database have identical product identifiers but have otherwise different product data;

a rule indicating that a potential error exists if two products in the seller database have different product identifiers but have otherwise identical product data; and

one or more rules indicating that a potential error exists if the values associated with particular generic product attributes have a non-numerical format; and

identify one or more potential errors in the product data according to the rules.

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<sup>1</sup> Applicants assume that the Examiner's indication on page 3 of the Office Action that Claim 33 is rejected instead of Claim 35 was inadvertent, particularly in light of the Examiner's acknowledgement of Applicants' election to prosecute Group I (Claims 1-11, and 34-35) and the Examiner's indication on the Office Action Summary that Claims 1-11, and 34-35 were rejected. (See Office Action, Summary Sheet and Pages 2-3)

**1. *Fassett* Fails To Disclose, Teach, Or Suggest Various Limitations Recited In Claim 1.**

*Fassett*, whether considered alone or in combination with knowledge generally available to one of ordinary skill in the art at the time of invention, fails to disclose, teach, or suggest various limitations recited in Claim 1.

Applicants respectfully submit that *Fassett* fails to disclose, teach, or suggest any content enhancement module, let alone a content enhancement module that is operable to “analyze product data stored in a seller database using one or more rules” or “identify one or more potential errors in the product data according to the rules,” as recited in Claim 1. Given that the Examiner’s explanation of his interpretation of *Fassett* vis-à-vis Applicants’ claims consists almost entirely of mentioning registration menu 160 of *Fassett*, it is difficult for Applicants to understand the Examiner’s position. It does not appear to Applicants that *Fassett* discloses any such rules, analysis of product data stored in a seller database using one or more rules, or identifying potential errors in the product data according to the rules. The Examiner does not indicate where in *Fassett* such rules are purportedly disclosed.

*Fassett* discloses that a supplier registers new products with controller 200 (by filling in a template for the types of products the supplier is authorized to register). (See Column 3, Lines 7-10 and Column 7, Lines 60 through Column 8, Line 1) Controller 200 generates a key code for the new product, scans a keytable database, and displays a list of similar key codes to the supplier. (See Column 8, Lines 6-8) The controller then asks the supplier if the product just registered duplicates any of those displayed or any others of which he is aware. (See Column 8, Lines 8-10) However, *Fassett* fails to disclose, teach, or suggest anything related a content enhancement module, let alone a content enhancement module that is operable to “analyze product data stored in a seller database using one or more rules” or “identify one or more potential errors in the product data according to the rules,” as recited in Claim 1.

Additionally, *Fassett* fails to disclose, teach, or suggest the following limitations recited in Claim 1:

. . . the rules comprising one or more generic rules applying to substantially all seller databases in the plurality of seller databases that include product data, the generic rules comprising one or more rules from the group consisting of:

a rule indicating that a potential error exists if two products in the seller database have identical product identifiers but have otherwise different product data;

a rule indicating that a potential error exists if two products in the seller database have different product identifiers but have otherwise identical product data; and

one or more rules indicating that a potential error exists if the values associated with particular generic product attributes have a non-numerical format.

No such generic rules are disclosed, taught, or suggested in *Fassett*. First, Applicants note that *Fassett* does not appear to even disclose a plurality of seller databases. Thus, *Fassett* necessarily fails to disclose, teach, or suggest one or more generic rules applying to substantially all seller databases in the plurality of seller databases that include product data. Second, *Fassett* does not disclose, teach, or suggest any rules selected from the group specified in Claim 1.

For example, *Fassett* does not disclose “a rule indicating that a potential error exists if two products in the seller database have identical product identifiers but have otherwise different product data,” as recited in Claim 1. At best, *Fassett* discloses a central database that requests a supplier to identify duplicate products. This type of manual identification of duplicates fails to disclose, teach, or suggest, and in fact teaches away from, the system disclosed in *Fassett* having any rules used in an analysis performed by a module of the system disclosed in *Fassett*. Even more clearly, it does not even appear that the system disclosed in *Fassett* has any ability to determine whether product data of two products is different.

As another example, *Fassett* does not disclose, teach, or suggest “a rule indicating that a potential error exists if two products in the seller database have different product identifiers but have otherwise identical product data,” as recited in Claim 1. At best, *Fassett* discloses a central database that requests a supplier to identify duplicate products. This type of manual identification of duplicates fails to disclose, teach, or suggest, and in fact teaches

away from, the system disclosed in *Fassett* having any rules used in an analysis performed by the system. Even more clearly, it does not even appear that the system disclosed in *Fassett* has any ability to determine whether product data of two products is identical.

As another example, *Fassett* does not disclose, teach, or suggest “one or more rules indicating that a potential error exists if the values associated with particular generic product attributes have a non-numerical format,” as recited in Claim 1. *Fassett* fails to disclose, teach, or suggest anything even remotely resembling such one or more rules.

The Examiner acknowledges that “*Fassett* does not specifically disclose a rule regarding duplicative product identifiers.” (Office Action, Page 3) The Examiner argues, “However, as understood, the system of *Fassett* provides a mechanism for parsing identical products. Thus, to have provided a rule indicating a potential error in a seller database for *Fassett* would have been obvious to one of ordinary skill in the art. The motivation for having done such would have been to have provided multiple distinct products to have been available for purchase in the marketplace.” (Office Action, Page 3)

Applicants respectfully disagree that *Fassett* provides a mechanism for parsing identical products, as asserted by the Examiner. Instead, as discussed above, *Fassett* discloses that a supplier registers new products with controller 200 (by filling in a template for the types of products the supplier is authorized to register). (See Column 3, Lines 7-10 and Column 7, Line 60 through Column 8, Line 1) The controller generates a key code for the new product, scans a keytable database, and displays a list of similar key codes to the supplier. (See Column 8, Lines 6-8) The controller then asks the supplier if the product just registered duplicates any of those displayed or any others of which he is aware. (See Column 8, Lines 8-10) Applicants respectfully submit that this is not a mechanism for parsing identical products; instead, the system disclosed in *Fassett* appears to rely entirely on a request to a supplier to manually identify duplicate products.

## **2. The Proposed Modifications To *Fassett* are Improper.**

In addition to the patentable distinctions discussed above, Applicants respectfully submit that the Examiner’s conclusory assertion that it would have been obvious to modify

the teachings of *Fassett* in the manner proposed by the Examiner to arrive at Applicants' invention is insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law. In particular, Applicants respectfully submit that the Examiner's attempt to modify *Fassett* amounts to improper hindsight reconstruction of Applicants' invention, using Applicants' claims as a blueprint.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. *See* 35 U.S.C. § 103(a). Accordingly, even if all elements of a claim are disclosed in one or more prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability

of the modification or combination. *See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.<sup>2</sup> According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

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<sup>2</sup> Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").



In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a sufficient motivation in the prior art to combine the references that allegedly create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

With respect to the Examiner's proposed modifications to *Fassett*, the Examiner summarily concludes that "to have provided a rule indicating a potential error in a seller

database for *Fassett* would have been obvious to one of ordinary skill in the art. The motivation for having done such would have been to have provided multiple distinct products to have been available for purchase in the marketplace.” (Office Action, Page 3) First, the Examiner has not cited any portion of *Fassett* that supports this purported motivation. Second, nothing in *Fassett* or in the knowledge generally available to those of ordinary skill in the art at the time of the invention teaches, suggests, or motivates in any way the proposed modifications to *Fassett*.<sup>3</sup> The Examiner's speculation that “it would have been obvious” at the time of the invention to modify teachings of *Fassett* to allegedly achieve Applicants’ invention (which even the proposed modifications would not accomplish), in hindsight with the benefit of Applicants’ claims as a roadmap, is insufficient under the M.P.E.P. and governing Federal Circuit case law.

The Examiner appears to have simply proposed an alleged advantage of modifying *Fassett* (which Applicants do not admit could even be achieved by modifying *Fassett* in the manner the Examiner proposes). The Examiner did not point to any relevant portions of *Fassett* that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to modify *Fassett* in the manner the Examiner proposes. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to even attempt* to incorporate into the teachings of *Fassett* rules for detecting potential errors in product data, as proposed by the Examiner. Even more clearly, it certainly would not have been obvious to one of ordinary skill in the art at the time of the invention, based solely on the prior art, *to actually* incorporate into the teachings of *Fassett* rules for detecting potential errors in product data, as asserted by the Examiner, which would be required to establish a *prima facie* case of obviousness under the M.P.E.P. and the governing Federal Circuit case law.

Applicants respectfully note that “the factual inquiry whether to combine references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 2001). Thus, the burden is on the Examiner to identify

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<sup>3</sup> Applicant requests that if the Examiner relies on “common knowledge” or “well known” art to modify *Fassett*, the Examiner provide a reference in support of this position pursuant to M.P.E.P. § 2144.03, or if the Examiner relies on personal knowledge to supply the required teaching, suggestion, or motivation to modify *Fassett*, the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. 2144.03.

concrete evidence in the record to support his conclusion that it would have been obvious to modify the teachings of the cited reference to achieve the claimed invention. *See, In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir. 2000). The Examiner's conclusory assertion that it would have been obvious to modify *Fassett* in the manner proposed by the Examiner does not provide a thorough and searching factual inquiry and does not identify any concrete evidence in the record for modifying *Fassett*.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to modify *Fassett* in the manner the Examiner proposes, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action fall well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Thus, Applicants respectfully submit that the Examiner's proposed modification of *Fassett* appears to be merely an attempt, with the benefit of hindsight, to reconstruct Applicants' claims in a manner not supported by the teachings of *Fassett*. Applicants respectfully submit that the rejection must therefore be withdrawn.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1 and its dependent claims.

**B. Dependent Claims 2-11 are Allowable over *Fassett***

Dependent Claims 2-11 depend from independent Claim 1, which Applicants have shown above to be clearly allowable over *Fassett*, and are allowable for at least this reason. In addition, dependent Claims 2-11 recite further patentable distinctions over *Fassett*. Applicants respectfully note that the Examiner did not address Applicants' dependent claims by providing Applicants with any reasons why the Examiner believes *Fassett* discloses the limitations recited in these dependent claims. Applicants do not believe that *Fassett* discloses, teaches, or suggests various limitations recited in dependent Claims 2-11. If the Examiner maintains the rejection of Claims 2-11, Applicants respectfully request that the

Examiner more particularly point out the portions of *Fassett* that the Examiner believes purportedly disclose the limitations recited in Claims 2-11.<sup>4</sup>

For at least these reasons, Applicants respectfully request reconsideration and allowance of dependent Claims 2-11.

**C. Independent Claim 34-35 are Allowable over *Fassett***

Applicants respectfully submit that *Fassett*, whether considered alone or in combination with knowledge generally available to one of ordinary skill in the art at the time of Applicants' invention, fails to disclose, teach, or suggest various limitations recited in independent Claims 34-35.

For example, *Fassett* fails to disclose, teach, or suggest, at a minimum, the following limitations recited in Claim 34:

- means for analyzing the product data stored in a seller database using one or more rules; and
- means for identifying one or more potential errors in the product data according to the rules.

As another example, *Fassett* fails to disclose, teach, or suggest, at a minimum, the following limitations recited in Claim 35:

- a content enhancement module operable to:
  - in response to a seller requesting that product data in a particular seller database be associated with one or more classes of the global content directory, using the content enhancement module to communicate one or more search queries to the seller database, the search queries formulated according to one or more rules associated with the particular classes with which the product data in the seller database is to be associated;
  - identifying one or more potential errors in the product data by determining the product data that is included in the results of one or more of the search queries; and
  - communicating the potential errors to a seller associated with the seller database.

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<sup>4</sup> Applicants respectfully submit that in general, with respect to all of Applicants' pending claims, it would be helpful if the Examiner would more clearly indicate which portions of *Fassett* the Examiner believes disclose the limitations recited in Applicants' claims. This would assist Applicants in understanding the Examiner's position and in responding to the Office Action.

As discussed above with reference to independent Claim 1, *Fassett* simply has nothing to do with using one or more rules to analyze product data or identifying potential errors in the product data according to the rules. Instead, the system disclosed in *Fassett* apparently relies on a supplier who registers products to identify duplicates, for example. Furthermore, *Fassett* clearly fails to disclose, teach, or suggest “in response to a seller requesting that product data in a particular seller database be associated with one or more classes of the global content directory, using the content enhancement module to communicate one or more search queries to the seller database, the search queries formulated according to one or more rules associated with the particular classes with which the product data in the seller database is to be associated,” as recited in Claim 35. The Examiner has not indicated any portions of *Fassett* that purportedly disclose, teach, or suggest these limitations.

Additionally, as discussed above, Applicants respectfully submit that the Examiner has not shown the requisite teaching, suggestion, or motivation in *Fassett* or in knowledge generally available to one of ordinary skill in the art at the time of Applicants’ invention to modify *Fassett* in the manner the Examiner proposes. Moreover, even if such teaching, suggestion, or motivation were assumed to exist and to have been properly shown by the Examiner, the Examiner’s proposed modifications would still fail to make up for the deficiencies of *Fassett*.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claims 34-35.

### **III. Information Disclosure Statements (IDSs)**

#### **A. Consideration of Previously-Filed IDSs**

The Examiner states that the July 24, 2003 and August 5, 2004 IDSs were received but were not reviewed because no references were received with the IDSs.” (Office Action, Page 3)

However, as indicated in the Request for Consideration of an Information Disclosure Statement Timely Filed, which was mailed on October 20, 2004 and the associated return

postcards for the IDSs, copies of the references were sent with the original IDSs. Applicants respectfully request that the Examiner make every effort to locate these references, as it would be rather expensive for Applicants to re-copy and resubmit each of these references.

Applicants also note that a new IDS, an accompanying PTO-1449 form, and a copy of each reference cited on the PTO-1449 form were mailed November 3, 2004. Applicants also respectfully request the Examiner to indicate consideration of the submitted references by initialing next to each reference on the PTO-1449 form.

**B. Examiner's Comments Regarding the Volume of the IDSs**

The Examiner states, "It is noted that the sheer volume of the proposed IDSs are daunting. It is suggested [that] Applicant point out the particular relevance of each reference in order to be reviewed diligently. Otherwise, a mere cursory review may result when the art is provided." (Office Action, Page 4).

The M.P.E.P. states that it is the province of the Examiner – not Applicants – to determine whether references cited in an IDS are material to patentability. *See* M.P.E.P. § 2001.04. For example, according to the M.P.E.P.:

[t]he definition of materiality in 37 CFR 1.56 does not impose substantial new burdens on applicants, but is intended to provide the Office with the information it needs to make a proper and independent determination on patentability. *It is the patent examiner who should make the determination after considering all the facts involved in the particular case.*

M.P.E.P. § 2001.04, ¶ 4 (emphasis added).<sup>5</sup> Furthermore, the M.P.E.P. admonishes Applicants against making their own determinations regarding materiality, stating: "[A]pplicants will . . . submit information for consideration by the Office in applications

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<sup>5</sup> Applicants also respectfully direct the Examiner's attention to M.P.E.P. § 609, which provides:

Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, the examiner has an obligation to consider the information. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search.

*rather than making and relying on their own determinations of materiality.*” M.P.E.P. § 2001.04, ¶ 11 (emphasis added).

Applicants respectfully submit that compliance with the Examiner’s request might be viewed as a determination of materiality by Applicants, contrary to the admonishment in the M.P.E.P. Moreover, Applicants respectfully submit that the Examiner’s request is contrary to 37 C.F.R. § 1.97(h), which states that the filing of an IDS shall not be considered to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 C.F.R. § 1.56. In light of 37 C.F.R. § 1.97(h) and M.P.E.P. § 2001.04, Applicants respectfully submit that it would be improper for Applicants to highlight any particular reference to the exclusion of others, or to point out any particular reasons why a reference may or may not be relevant. Moreover, Applicants are concerned that doing so might be inaccurately and unfairly interpreted as calling undue attention to one or more references to divert attention from other references or portions of references that are not specifically discussed. Applicants are not required to provide any reasons why a particular reference may or may not be relevant, or to rank the relevance of any particular reference versus another.

Since Applicants are not required to rank the relevance of the references and because such action could prejudice Applicants, Applicants respectfully decline the Examiner’s request. Applicants, however, remain willing to address any particular reference the Examiner may wish to discuss. Thus, Applicants respectfully request that the Examiner make an independent determination regarding the relevance and the relative importance, if any, of the references cited in the IDSs, and that the Examiner make this determination at least by “considering the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search,” as required by M.P.E.P. § 609.

**IV. No Waiver**

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner's rejections.



**Conclusion**

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicants, at the Examiner's convenience at (214) 953-6812.

Applicants enclose a check in the amount of \$120.00 to cover the cost of a one-month extension of time. Although Applicants believe that no other fees are due, the Commissioner is hereby authorized to charge any other fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorneys for Applicants



Christopher W. Kennerly  
Reg. No. 40,675

Date: February 7, 2005

Correspondence Address:

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